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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) UV-179	
	Application Number 09/775,115	Filed February 1, 2001	
	First Named Inventor Johnny B. Corvin		
	Art Unit 2623	Examiner J. E. Shepard	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>L0381</u></p> <p><u>Regina Sam</u> Signature</p> <p><u>Regina Sam</u> Typed or printed name</p> <p><u>(617) 951-7814</u> Telephone number</p> <p><u>July 23, 2008</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: <u>7-23-08</u>	Signature: <u>Mary Murphy</u> (Mary Murphy)



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to:
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Dated: 7-23-08

Signature: Mary Murphy
(Mary Murphy)

Docket No.: UV-179
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Johnny B. Corvin

Application No.: 09/775,115

Confirmation No.: 8786

Filed: February 1, 2001

Art Unit: 2623

For: METHODS AND SYSTEMS FOR FORCED
ADVERTISING

Examiner: J. E. Shepard

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicant requests review of the final rejection of claims 14-16, 40-48, and 69-80 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

REMARKS

Introduction

Claims 14-16, 40-48, and 69-80 are pending in this application. In the Final Office Action mailed January 25, 2008, claims 14, 16, 40, 42, 43, 45, 46, and 48 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond") in view of Mori Japanese Patent No. 410162484A ("Mori") and Aoyama Japanese Patent No. 408076778A ("Aoyama"). Claims 15, 41, 44, and 47 were finally rejected under 35 U.S.C. § 103(a)

as being unpatentable over Zigmond in view of Mori, Aoyama, and Hite et al. U.S. Patent No. 6,002,393 ("Hite"). Claims 69, 71, 72, 74, 75, 77, 78, and 80 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori and Russo et al. U.S. Patent No. 5,619,247 ("Russo"). Finally, claims 70, 73, 76, and 79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Russo, Mori, and Hite.

For the purposes of this Request, applicant will specify the omission of essential elements required to make a *prima facie* rejection of claims under 35 U.S.C. § 103(a). In particular, applicant will show that the alleged combination does not produce the claimed invention and further that there is no motivation to modify Zigmond in the manner suggested by the Examiner. Applicant reserves the right to present additional arguments upon the decision of the panel review.

The § 103 Rejections of the Independent Claims

Each of independent claims 14, 40, 43, 46, 69, 72, 75, and 78 is directed to presenting a forced advertisement on user equipment. The forced advertisement is detected in an incoming video stream and presented on the user equipment. The user equipment is turned off while the forced advertisement is being presented. When the user equipment is turned on, the forced advertisement is automatically presented from the beginning of the forced advertisement (claims 14, 40, 43, and 46) or recommenced from the point at which the user equipment was turned off (claims 69, 72, 75, and 78).

Zigmond describes selecting and inserting advertisements into a video programming feed. As shown in FIG. 6 of Zigmond, a home entertainment system "receives video programming from a content provider and displays the video programming." (Col. 17, ll. 21-23.) A stored advertisement is selected and an "ad insertion device *waits for a triggering event that indicates an appropriate time to insert the selected advertisement.*" (Col. 17, ll. 23-28, emphasis added.) The triggering event is "a designated signal encoded in video programming feed" or may be implied by "the conventional pattern of advertisements in [the] video programming feed." (Col. 8, ll. 39-45.) To address advertisement avoidance by so-called "aggressive channel surfers," Zigmond proposes that a video switch "inserts one particular advertisement into each advertisement slot that the channel

surfer encounters as he or she progresses through the channel lineup” so that “the channel surfer is repeatedly exposed to at least bits and pieces of the one particular advertisement.” (Col. 13, ll. 20-26, emphasis added.) Alternatively, “the video programming broadcast ... is coordinated so that each channel simultaneously broadcasts advertisement slots” and “a selected advertisement is displayed simultaneously on all of the multiple channels.” (Col. 13, ll. 29-35.)

Mori describes a "CD reproducing device" which is able to resume reproducing from a "reproducing interrupted spot" without any time delay when a power source is switched ON again after the power source is switched OFF (Mori, Abstract). Mori does not mention using the system for advertisements.

The Examiner concedes that Zigmond does not teach resuming an interrupted advertisement from the beginning or from the point of interruption when the user equipment is turned off and then back on. However, the Examiner contends that Zigmond may be modified according to Mori to add this resuming feature for advertisements. (See Office Action, pp. 4 and 5). Applicant disagrees.

First, the combination of Zigmond and Mori (with either Aoyama or Russo) would not produce the claimed invention. Zigmond repeatedly states that a video programming feed received from a content provider may be interrupted to display a stored advertisement only at "an appropriate time" indicated by specific "triggering events." See, e.g., Col. 17, ll. 23-28 ("the ad insertion device waits for a triggering event that indicates an appropriate time to insert the selected advertisement"); Col. 7, ll. 25-32 ("At an appropriate time specified by encoded data in video programming feed 52 or by the structure of video programming feed 52, the household advertisement insertion device 60 interrupts the display of the video programming feed 52 [and an] ... advertisement 59 ... is then displayed to the viewer"); Abstract ("the advertisement insertion device monitors the programming feed for a triggering event indicating an appropriate time to display the selected advertisement."). A common thread through Zigmond is the strategic insertion of advertisements into the programming feed so that advertisements are displayed only in "advertisement slots" determined by the content provider and indicated by a triggering event carried in the video programming feed originating from the content provider. Even in the discussion of "aggressive channel surfers," advertisements are displayed to a channel surfer only if the surfer "encounters" a pre-scheduled "advertisement slot"

while progressing through the channel lineup. At no point does Zigmond teach or suggest that the video programming feed may be interrupted to display an advertisement simply because a viewer chose to change channels or, in this case, previously turned off the user equipment while the advertisement was being displayed.

Mori, which includes a content resuming feature, fails to make up for this deficiency. Mori is completely silent about resuming playback of advertisements. Because programming content in Zigmond is carried in a video programming feed that is received from a content provider and displayed by the home entertainment system, the combination with Mori would at best result in a home entertainment system with the capability to display both content received from a content provider and that stored on a CD, with the CD content being resumed if interrupted by a power down. Nothing in either Zigmond or Mori suggests any coordination between the CD and video feed so that advertisements triggered by the video feed will be resumed using the CD playback feature if interrupted by a power down. Moreover, because CDs generally contain content that a viewer wants to watch (as evidenced by their willingness to voluntarily obtain and insert the CD into a CD player), it may be obvious to try to resume interrupted content on a CD. However, the Examiner provides no rational reason for why a content provider would store advertisements for a video programming feed on a CD, when the programming content is itself displayed upon receipt from the content provider.

Aoyama and Russo are relied on for their purported teachings regarding whether the advertisement is resumed from the beginning or from the point of interruption. Both completely silent regarding the behavior of the system in Zigmond if an advertisement is interrupted by turning off the user equipment on which it is being displayed.

Second, even if the alleged combination would produce the claimed invention, which it would not, there is no motivation to modify Zigmond in the manner suggested by the Examiner. While the Supreme Court, in KSR Int'l Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007) ("KSR"), determined that the teaching, suggestion, or motivation ("TSM") test cannot be applied rigidly, the Court acknowledged that the TSM test captures a helpful insight and is one of a number of valid rationales that could be used to determine obviousness (KSR, 127 S.Ct. at 1737). "The key to

supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." (MPEP 2143) The Examiner here provides no rational basis outside of applicant's disclosure to suggest why one skilled in the art would modify Zigmond to go against its basis tenets and trigger advertisements based on local user actions rather than a triggering event determined by the content provider. Rather, with the knowledge of applicants' novel systems and methods for presenting forced advertisement, the Examiner identified and isolated particular features of Mori and Aoyama for use in combination with Zigmond to reject applicant's invention, without providing the requisite evidence for combining these references. In doing so, the Examiner has simply taken applicants' disclosure as a blueprint for piecing together these references, thereby demonstrating mere hindsight reconstruction, which is the very syndrome that the requirement for objective evidence is designed to combat. See In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999).

Conclusion

For at least the above reasons, applicant submits that requirements for establishing a prima facie case of obviousness have not been met to support the rejection of independent claims 14, 40, 43, 46, 69, 72, 75, and 78 under 35 U.S.C. § 103(a). The dependent claims are also not obvious for at least the same reason. Accordingly, applicant respectfully requests that the panel issue a written decision withdrawing the rejection of the claims.

Applicant believes no fee is due with this response, other than what is reflected on the enclosed Fee Transmittal. However, if an additional fee is due, please charge our Deposit Account No. 06-1075, under Order No. 003597-0179 from which the undersigned is authorized to draw.

Dated: July 23, 2008

Respectfully submitted,

By Regina Sam
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